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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 10/613,334 | 07/03/2003 | Joseph Saladino | IOI-453 | 5122 |
| 45488 | 7590 | 01/05/2006 | EXAMINER | |
| WILLIAMS, MORGAN & AMERSON | | | PREBILIC, PAUL B | |
| 10333 RICHMOND, SUITE 1100 | | | ART UNIT | |
| HOUSTON, TX 77042 | | | PAPER NUMBER | |

3738

DATE MAILED: 01/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,334

Applicant(s)

SALADINO ET AL.

Examiner

Paul B. Prebilic

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-24 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/28/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 28, 2005 has been entered.

Claim Objections

Claims 21-24 and 30-34 are objected to because of the following informalities:

Regarding claims 21-24, on line 5 of claim 21, the language "at least one spacer inserted into" lacks clear antecedent basis. The Examiner suggests replacing this language with "at least one of said plurality of spacers inserted into" in order to overcome this objection. Claims 22-24 are dependent upon claim 21 and therefore have the same language by incorporation.

Regarding claims 21-24, on lines 9-10, the language "said at least one spacer" lacks clear antecedent basis. The Examiner suggests changing this language to "said at least one of said plurality of spacers" in order to overcome this objection. Appropriate correction is required.

Regarding claim 30, on line 7, "threadingly engageable" does not agree with the previous line that requires that the neck be at least partially positioned with the bore. The disclosed device only discloses a neck where it is threaded all the way up to the end inserted into the bore; see Figure 4. For this reason, the language "threadingly

engageable” should be “threadingly engaged” to be consistent with line 6 of the claim and to be consistent with the neck as disclosed in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 30-32 are rejected under 35 U.S.C. 102(b) as anticipated by Rose et al (US 3,102,356) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rose et al (US 3,102,356) in view of Subba Rao et al (US 2001/0051831) or Fuchs (DE 20022306). Rose anticipates the claim language where the femoral head as claimed is met by the head (10) of Rose, the neck as claimed is neck (6), and the spacer is stop rings (a) of various thicknesses; see column 2, lines 37-42 and also see the disclosure of Figures 5 and 7 as well as column 1, line 55 to column 2, line 55. The Examiner asserts that the stem part of Rose is capable of fitting into a stem to the extent that this language can be given patentable weight and that the claim language is fully met in this regard.

Alternatively, one may not consider the stem of Rose as capable of insertion into a stem. However, Subba Rao or Fuchs teaches that it was known to make detachable necks that can be attached to a stem portion; see the figures of both patents. Therefore, it is the Examiner's position that it would have been obvious to make the neck of Rose detachable so that it could be fit to different stems to better adapt the invention to the particular patient.

Claims 22-24 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose et al, Subba Rao et al, and Fuchs, as applied against claims 21 and 30-32, in further view of Rose et al (US 3,102,356). Rose fails to disclose the use of the particular sizes claimed or a plurality of them in the bore as claimed. However, since Rose teaches that it was contemplated to use stops of various thicknesses (see column 2, lines 37-43), it is the Examiner's position that it would have been obvious to use stops of particular thicknesses or multiples of such stops in order to adapt the invention to the particular needs of the patient.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Prebilo", with a stylized flourish at the end.

Paul Prebilo
Primary Examiner
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